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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/035,347

Applicant(s)

REEDER ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/5/02; 7/16/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the application filed on December 28, 2001. Claims 1-29 are pending. Claims 1-29 are examined.

### ***Claim Objections***

2. Claims 7 and 25 are objected to because of the following informalities:
  - a) in line 9 of claim 7, the phrase "the potential licensee" should be "a potential licensee";
  - b) in line 4 of claim 25, the phrase "the network" should be "a network";
  - c) in line 4 of claim 25, the phrase "the user" should be "a user";
  - d) in line 5 of claim 25, the phrase "the licensor" should be "a licensor".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites "an indication that the user is not proceeding..." in lines 11-12. It is not clear "the user" refers to the recitation "a user regarding at least a first right" in lines 7-8, or refers to the recitation "a user response" in line 10.

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Claims 26-29 are rejected for incorporating the errors of their respective base claim 25 by dependency.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-6, 11 and 13-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 1 and 3-6, applicant claims functional descriptive materials (i.e. a rights owner application, repository database, rights exchange application) that are not embodied in computer readable media. According to MPEP 2106 IV B 1 (a), "Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer". Applicant is advised to either embody the data in a computer readable media or a computerized apparatus, such as change "a rights owner application" to "a rights owner computer terminal".

As to claims 11 and 13-24 are also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 11 and 13-24 only recites an abstract idea. The recited steps of merely receiving rights licensor instructions and conducting license transactions do not apply, involve, use, or advance the technological arts since **the recited steps can be performed in the mind of the user or by use of a pencil and paper**. These steps only constitute an idea of how to better managing license rights.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention receiving rights licensor instructions and conducting license transactions (i.e., useful, concrete and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 11 and 13-24 are deemed to be directed to non-statutory subject matter. Applicant is advised to implement the technology into the claims, such as "electronically receiving a right licensor...", "electronically conducting...", etc.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 7-9, 11-12, 14-20, 24-25 and 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Misra et al., U. S. Patent 6,189,146.

As to claims 7 and 19, Misra teaches a system for managing intellectual property rights, comprising (Fig. 3):

- a) a first module configured to receive over a network information related to intellectual property rights available for at least a first property from an intellectual property rights licensor (column 7 lines 21-64 and column 8 line 60 – column 10 line 2 and Fig. 3);
- b) a repository coupled to the first module, wherein the repository is configured to store the information related to the intellectual rights for the first property (column 8 line 60 – column 10 line 2 and Fig. 3);
- c) a second module configured to:
  - i) present to the potential licensee a first license form defined by the intellectual property rights licensor (column 15 line 56 – column 16 line 6 and Fig. 7; *specifically, “a first license form” corresponds to the platform challenge sent to the potential licensee in Misra’s teaching*);

- ii) receive data entered into the first license form by the potential licensee, the data including a request to license a first right (column 15 line 56 – column 16 line 6 and Fig. 7);
- iii) determine if the first right is available, and if the first right is available, to submit the license request, including at least a portion of the received data, to the licensor (column 15 lines 4-28 and Fig. 6; *specifically, the “licensor” corresponds to the secure license store 112 in Misra’s teaching*);
- iv) transmit a license approval to the potential licensee (column 15 lines 11-28 and Fig. 6).

As to claim 8, Misra teaches the license approval is provided by the licensor after the received data is transmitted to the licensor (column 15 lines 4-28 and Figs. 6-7).

As to claim 9, Misra teaches the repository is configured to indicate when the first right has been licensed to the potential licensee in real time (column 15 lines 25-28).

As to claim 11, Misra teaches a method of managing and licensing rights associated with media, the method comprising (Fig. 3):

- a) receiving from a rights licensor of a first media an instruction defined which system entities and entity attributes can be used as search parameters by a search engine (column 10 line 45 – column 11 line 30 and Fig. 3);
- b) receiving from the rights licensor a definition of information types that a potential licensee is to provide in a license request submission for at least a first right for the first media (column 9 Table 4 and column 11 Table 5 and column 15 line 66 – column 16 line 6 and Fig. 3);

- c) receiving from the rights licensor a definition of at least a portion of a licensing transaction workflow to be used in a licensing transaction for at least the first right (column 15 lines 4-28; *specifically, this limitation is taught by Misra as according to the license rule, the rights licensor transmits the first right only if the client is authenticated*);
- d) receiving from the rights licensor instructions as to what notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction (column 15 line 47 – column 16 line 37 and Figs. 6-7; *specifically, this limitation is taught by Misra as according to the license instructions, the right licensor and the potential licensee send each other responses corresponding to the license request*);
- e) receiving from the rights licensor authorizing instructions configured to specify who is authorized to perform predetermined acts during the licensing transaction (column 10 line 60 – column 12 line 14 and column 15 lines 4-28 and Figs. 3, 6);
- f) conducting the licensing transaction in accordance with the rights licensor's notification instructions, rights licensor defined workflow, and authorizing instructions (column 15 line 47 – column 16 line 37 and Figs. 6-7).

As to claim 12, Misra teaches receiving a licensing a request over the Internet from the potential licensee (column 4 lines 9-14).

As to claim 14, Misra teaches the system entities include one or more of properties, rights, requests, agreements, licenses, licensees, and licensors (column 9 Table 4 and column 11 Table 5).



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As to claim 15, Misra teaches the system attributes include one or more of a term start, and a term end (column 11 Table 5).

As to claim 16, Misra teaches the rights licensor uses a license template to define the information types that the potential licensee is to provide (column 15 line 56 – column 16 line 6 and Fig. 7; *specifically, “a license template” corresponds to the platform challenge sent by the license server in Misra’s teaching*).

As to claim 17, Misra teaches the rights licensor specifies how the notifications are to be provided (column 15 line 47 – column 16 line 37 and Fig. 6).

As to claim 18, Misra teaches at least one of the notifications includes status information on the licensing transaction (column 15 lines 50-54 and column 16 lines 35-37).

As to claim 20, Misra teaches if the response from the rights licensor is a license approval, updating in real time a database used to store right status information (column 15 lines 25-29).

As to claim 24, Misra teaches the first media is a document (column 14 lines 47-48 and Figs. 3-6).

As to claim 25, Misra teaches an apparatus for managing licensing transactions related to media rights, the apparatus comprising (Fig. 3):

- a) a first instruction stored in computer readable memory, the first instruction configured to transmit over the network to the user licensing terms defined by the licensor for a first media property (column 9 Tables 3-4 and column 11 Table 5);

- b) a second instruction stored in computer readable memory, the second instruction configured to receive over a network a license inquiry from a user regarding at least a first right for the first media property (column 13 line 66 – column 14 line 59 and Figs. 3, 5-6);
- c) a third instruction stored in computer readable memory, the third instruction configured to receive a user response to the licensing terms, the user response including one of a license acceptance, and an indication that the user is not proceeding with the licensing transaction (column 11 Table 5 and column 15 line 47 – column 16 line 37 and Figs. 3, 6-7);
- d) a fourth instruction stored in computer readable memory, the fourth instruction configured to set a first status in real-time related to the first right at least partly in response to the user response (column 15 line 4 – column 16 line 37 and Figs. 3, 6-7);
- e) a fifth instruction stored in computer readable memory, the fifth instruction configured to transmit a notification relating to the user response to a recipient designated by the licensor (column 15 line 47 – column 16 line 37 and Figs. 3, 6);
- f) a sixth instruction stored in computer readable memory, the sixth instruction configured to receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the first right (column 15 lines 25-29).

As to claim 27, Misra teaches the user inquiry specifies a territory for the license (column 8 Table 2 and column 15 line 66 – column 16 line 6).

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As to claim 28, Misra teaches the user inquiry specifies a media language (column 8 Table 2 and column 15 line 66 – column 16 line 6).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U. S. Patent 6,189,146.

As to claim 26, Misra teaches a license inquiry from a user as discussed in claim 25 above. Misra does not specifically teach the user inquiry specifies a license time period. However, Misra teaches license term comprising time period (column 11 Table 5). It would have been obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include specifying a license time period so that the licensor can quickly match the user's inquiry.

11. Claims 1-6, 13, 21-23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U. S. Patent 6,189,146 in view of Griswold, U. S. Patent 5,940,504.

As to claims 1 and 3, Misra teaches a media lights licensing apparatus, comprising (Fig. 3):

e) a rights owner application configured to execute on a computer configured to receive workflow rules, and a license request template defined by a rights owner

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(column 7 lines 21-64 and column 8 line 60 – column 10 line 2 and column 15 line 56 – column 16 line 6 and Figs. 3, 7; *specifically, “a rights owner” corresponds to the license server in Misra’s teaching, and “a license request template” corresponds to the platform challenge sent from the license server as shown in Fig. 7 and column 15 line 56 – column 16 line 6*);

f) a repository database coupled to the rights owner application, wherein the repository is configured to store the workflow rules, and license request templates defined by the rights owner (column 8 line 60 – column 10 line 2 and Fig. 3);

g) a rights exchange application coupled to the repository database, the rights exchange application configured to (Intermediate Server 32 in Fig. 3) :

- i) receive a licensing request from a potential licensee related to a first media property (column 14 lines 14-29 and Figs. 3, 5);
- ii) conduct a licensing transaction of at least a first right associated with the first media property by determining rights available for the first media property by searching the repository database (column 14 line 49 – column 15 line 28 and Figs. 3, 5-6);
- iii) present a first license template defined by the rights owner (column 14 line 64 – column 15 line 3 and Figs. 3, 6-7);
- iv) receive first license template entries from the potential licensee (column 15 lines 4-8 and Figs. 3, 6-7);

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- v) transmit in real-time the first license template entries to the rights owner (column 15 lines 4-28 and Figs. 6-7);
- vi) receive from the rights owner approval of a license for the first right, and to transmit the approval to the potential licensee (column 15 lines 9-28 and Figs. 3, 6-7).

Misra does not specifically teach the rights owner application receiving pricing rules and payment rules, and the repository database store the pricing rules. However, Griswold teaches the rights owner has pricing rules and payment rules for licenses provide to the licensee, and a repository database stores the pricing rules (column 3 lines 38-41 and column 4 lines 34-40 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the rights owner application in Misra's teaching to include the feature of pricing rules and payment rules, and further to include the feature of storing the pricing rules by a repository database as taught by Griswold for allowing the rights owner to better managing his or her property.

As to claim 2, Misra teaches a rights search engine wherein the rights owner can configure which system entities and which attributes for the system entities can be used as searchable parameters by the search engine (column 9 lines 29-67 and column 10 lines 53-59).

As to claim 4, Misra teaches a plurality of rules defined by the rights owner, the rules configured to define which media rights licensing apparatus users are authorized to perform predefined actions (column 10 line 60 – column 12 line 14 and Fig. 3).

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As to claim 5, Misra teaches the predefined actions include accepting a licensing request and denying a licensing request (Figs. 5-7).

As to claim 6, Misra teaches a plurality of notifications defined by the rights owner, the plurality of notifications configured to be issued during the licensing process in response to criteria specified by the rights owner (column 15 lines 47-54 and column 16 lines 7-37 and Fig. 6).

As to claim 13, Misra teaches managing licensing rights as discussed in claim 11 above. Misra does not specifically teach receiving from the rights licensor pricing, payment and delivery rules. However, Griswold teaches this matter (column 3 lines 38-41 and column 4 lines 34-40 and column 7 line 3-26 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the rights licensor in Misra's teaching to pricing, payment and delivery rules as taught by Griswold for allowing the rights licensor to better managing his or her property.

As to claims 21-22, Misra teaches a method of managing and licensing rights associated with media. Misra does not specifically teach the media is a movie or a musical performance. However, Griswold teaches this matter (column 1 lines 16-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the media in Misra's teaching to include a movie or a musical performance as taught by Griswold because this would expand the usage environment of Misra to attract more users to use Misra's teaching for efficiently managing licensing rights.

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As to claim 23, Misra teaches a method of managing and licensing rights associated with media. Misra does not specifically teach the media is a movie or a musical performance. However, Griswold teaches the media comprising various types of products (column 1 lines 16-22). It would have been obvious to one of ordinary skill in the art allow the product in Griswold's teaching to include a photograph because this would expand the usage environment of Griswold. For the same reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the media in Misra's teaching to include a photograph as taught by the modified teaching of Griswold because this would expand the usage environment of Misra to attract more users to use Misra's teaching for efficiently managing licensing rights.

As to claim 29, Misra teaches an apparatus for managing licensing transactions as discussed in claim 25 above. Misra does not specifically teach the licensing terms include a payment due date. However, Griswold teaches this matter (column 7 lines 14-24 and Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the licensing terms in Misra's teaching to include a payment due data for ensuring the royalty payment to the licensor.

12. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U. S. Patent 6,189,146 in view of Domenikos, U. S. Patent 5,838,910.

As to claim 10, Misra teaches the repository is configured to determine the availability of intellectual property rights through bi-directional navigation and implied data relations (Fig. 3). Misra does not specifically teach determining the availability of intellectual property rights through bi-directional hierarchical navigation relations.

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However, Domenikos teaches property rights file is stored in a hierarchical relationship (column 3 lines 49-55 and column 5 lines 33-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the intellectual property rights in Misra's teaching to be determined through hierarchical relationship so that the intellectual property rights can be more efficiently managed.

### ***Conclusion***

13. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wyman (U. S. Patent 5,438,508) discloses license document interchange format for license management system.

Bains et al. (U. S. Patent 5,579,222) discloses using a local policy server to communicate with a license server.

Stefik et al. (U. S. Patent 6,236,971) discloses controlling distribution and use of digital works.

Herpel (EP 1 045 388) discloses preventing illegal usage of multimedia content.



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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
November 1, 2004

